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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER TRAN, ELLEN C	
			ART UNIT 2134	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardncr@oblon.com

**Office Action Summary**

Application No.

10/760,456

Applicant(s)

OHARA ET AL.

Examiner

Ellen C. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 10/760,456.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>JAN'04</u> . | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

1. This action is responsive to: an original application filed on 21 January 2004, with acknowledgement of the benefit of foreign application JP P2003-012765 filed 21 January 2003, and foreign application JP P2003-0383060 filed 12 November 2003.
2. Claims 1-15 are pending; claims 1, 4, 10, 11, 12, and 13, are independent claims.
3. The IDS submitted 21 January 2004 has been considered.

***Claim Objections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 10-15 are objected to under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrasing of the independent claims, appear to be a poor translation because they are repetitive and indefinite. The Examiner interprets claim 12 to mean the following:

A writing method comprising:

a first electronic watermark is embedded in the first identifier, and the first electronic watermark in the first identifier is embedded and is encrypted;

writing a second identifier in a data area, the second identifier location being obtained by decrypting the first identifier;

writing content data to the data area,

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the content data having at least one characteristic in which the content data is encrypted, the content data is a second encrypted electronic watermark;

and writing a replay program to the data area, the replay program being configured to make a computer execute instructions comprising:

instructions configured to read the first identifier from the identifier area;

instructions configured to read the second identifier from the data area;

instructions configured to conduct operations of: decrypting the second identifier, decrypting the first identifier, confirming if the second identifier is the first electronic watermark embedded therein;

if the second identifier being confirmed as being the first electronic watermark embedded therein when at least a predetermined part of the first and second identifiers are identical to each other;

executing instructions configured to read the content data from the data by decrypting the content data, and instructions configured to replay the content data.

Independent claims 10, 11, and 13, contain similar errors as claim 12 and are interpreted and rejected below.

6. To expedite a complete examination of the instant application the claims objected under 35 U.S.C. 112 above are further rejected as set forth below in anticipation of applicant amending these claims to correct the indefinite phrasing noted above.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1-9**, are rejected under 35 U.S.C. 102(e) as being anticipated by Dell U.S. Patent No. 6,745,944 (hereinafter '944).

**As to independent claim 1, A storage device comprising: a storage medium having a data area configured to write content data thereto and an identifier area configured to write an identifier thereto**" is taught in '944 col. 1, lines 54-62, note the storage medium is the smart card, the identifier area is the display area that shows which applications are loaded;

**"and a storage medium support frame configured to hold the storage medium and provided with visible information that corresponds to the identifier, the visible information being visible from the outside and selected from the group consisting of a character, symbol, pattern, color, and combination of a character, symbol, pattern, and color"** is shown in '944 col. 2, lines 18-25, note the 'support frame' is the interface for the smartcard which incorporates a display for displaying symbols or logos of loaded applications.

As to dependent claim 2, **“wherein: the storage medium support frame has a substantially rectangular shape and a short side of at least 31.8 mm”** is taught in ‘933 col. 1, lines 12-15, note a credit card is a rectangular shape with a short side of at least 31.8mm.

As to dependent claim 3, **“wherein: the identifier is readable by a writing apparatus; and the writing apparatus displays, on a display thereof, information selected from the group consisting of a character, symbol, pattern, color, and combination of a character, symbol, pattern, and color, and when the visible information agrees with the displayed information, conducts writing”** is shown in ‘944 col. 2, lines 18-25, note the interface is also a writing apparatus.

As to independent claim 4, **“A writing apparatus comprising: a storage unit configured to store an identifier, a software file name, a title of the software, and a visible information file that are related to one another; a display controller configured to read the visible information file and the title from the storage unit and output a display signal to display visible information and the title”** is taught in ‘944 col. 2, lines 18-25, note logos of the loaded application is interpreted to be equivalent to a title;

**“a display configured to receive the display signal from the display controller and display the visible information and the title; a slot configured to receive a storage device therein; an identifier reader configured to read an identifier stored in the storage device inserted in the slot”** is shown in ‘944 col. 2, lines 36-44, note card reader or automated teller are known in the art to have a ‘slot’ for receiving the smartcard;

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**“an identifier-corresponding-software searcher configured to determine if software corresponding to the identifier read by the identifier reader is stored in the storage unit”** is disclosed in ‘944 col. 2, line 57 through col. 3, line 9, note the loader application verifies and authenticates if the identified software is on the smartcard;

**“and a writer configured to write the software corresponding to the identifier to the storage device, when the software corresponding to the identifier is present”** is taught in ‘944 col. 4, lines 24-56, note the interface executes the selected loaded application, part of executing entails writing as interpreted by the Examiner access file, updating memory in smartcard.

As to dependent claim 5, **“wherein the storage device comprises: a storage medium having a data area configured to write content data thereto and an identifier area configured to write an identifier thereto; and a storage medium support frame configured to hold the storage medium and provided with visible information that corresponds to the identifier, the visible information being visible from the outside and selected from the group consisting of a character, symbol, pattern, color, and combination of a character, symbol, pattern, and color”** is shown in ‘944 col. 2, lines 17-36.

As to dependent claim 6, **“wherein: the storage medium support frame has a substantially rectangular shape and a short side of at least 31.8 mm”** is disclosed in ‘944 col. 1, lines 12-15, note a credit card is a rectangular shape with a short side of at least 31.8mm.

As to dependent claim 7, **“wherein: the writer conducts the writing when the visible information on the storage medium agrees with the visible information displayed on the**

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**display, the visible information on the display being selected from the group consisting of a character, symbol, pattern, color, and combination of a character, symbol, pattern, and color”** is taught in ‘944 col. 2, line 52 through col. 3, line 9.

**As to dependent claim 8, “further comprising: a correspondence table rewriter configured to rewrite a correspondence table showing correspondence among the identifier, file name, title, and visible information file”** is shown in ‘944 col. 2, line 52 through col. 3, line 9.

**As to dependent claim 9, “further comprising: a communication unit configured to receive data required to rewrite the correspondence table from outside of the writing apparatus”** is disclosed in ‘944 col. 3, lines 27-46.

9. **Claims 10-13**, are rejected under 35 U.S.C. 102(e) as being anticipated by Venkatesan et al. U.S. Patent No. 6,898,706 (hereinafter ‘706).

**As to independent claim 12, “A writing method comprising: writing a second identifier in a data area, the second identifier being obtained by at least one operation in which a first identifier written in an identifier area is encrypted, a first electronic watermark is embedded in the first identifier, and the first electronic watermark in the first identifier is embedded and is encrypted”** is taught in ‘706 col. 5, lines 21-40, as note multiple watermarks are interpreted to be equivalent to a second watermark, the enforcer watermark specifies the location of the watermark;

**“writing content data to the data area, the content data having at least one characteristic in which the content data is encrypted, the content data is a second electronic**



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**watermark embedded therein, and the content data is the second electronic watermark embedded therein and is encrypted; and writing a replay program to the data area, the replay program being configured to make a computer execute instructions comprising: instructions configured to read the first identifier from the identifier area; instructions configured to read the second identifier from the data area; instructions configured to conduct an operation selected from the group consisting of decrypting the second identifier, confirming if the second identifier is the first electronic watermark embedded therein, and decrypting the second identifier and confirming if the second identifier is the first electronic watermark embedded therein; instructions configured to compare the first identifier and the second identifier with each other when a case selected from the group consisting of the second identifier being decrypted, the second identifier being confirmed as being the first electronic watermark embedded therein, and the second identifier being decrypted and being confirmed as being the first electronic watermark embedded therein is satisfied; instructions configured to read the content data from the data area; instructions configured to conduct an operation selected from decrypting the content data, confirming if the content data is the second electronic watermark embedded therein, and decrypting the content data and confirming if the content data is the second watermark embedded therein, when at least a predetermined part of the first and second identifiers are identical to each other; and instructions configured to replay the content data when a case selected from the group consisting of the content data being decrypted, the content data being confirmed as being the second electronic watermark embedded therein, and the content data being decrypted and being confirmed as being the second electronic watermark embedded therein is satisfied” is shown in ‘706 col. 5, lines 37-59; note the watermark**

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becomes glue between the protected content and its license, if a value of a parameter in the license matches the same parameter in the license the enforcer permits access in accordance with license rights. Note the parameter value matching is interpreted to be equivalent to the 'predetermined part of the first and second identifiers are identical'.

**As to independent claim 10**, this claim is directed to program executing the instructions of the method of claim 12; therefore it is rejected along similar rationale.

**As to independent claim 11**, this claim is directed to a computer readable storage medium executing the instructions of the method of claim 12; therefore it is rejected along similar rationale.

**As to independent claim 13**, this claim is directed to a writing apparatus executing the instructions of the method of claim 12; therefore it is rejected along similar rationale.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. **Claims 14 and 15**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatesan et al. U.S. Patent No. 6,898,706 (hereinafter '706) in view of Dell U.S. Patent No. 6,745,944 (hereinafter '944).

As to dependent claim 14, the following is not explicitly taught in '706: **“and a storage medium support frame configured to hold the storage medium and provided with visible information that corresponds to a part of the identifiers, the visible information being visible from the outside and selected from the group consisting of a character, symbol, pattern, color, and combination of a character, symbol, pattern, and color”** however '944 teaches displaying visible information about the content in a secure storage medium in col. 1, lines 54-67.

It would have been obvious to one of ordinary skill in the art at the time of the invention a contents management system taught in '706 to include to show a user what programs application are available on a secure storage medium. One of ordinary skill in the art would have been motivated to perform such a modification to provide a convenient system of what applications are loaded see '944 (col. 1, lines 33 et seq,) “However, the applicant of the present invention recognized that one of the problems in a wide-spread adoption of a multi-application smart card by the industry is that there is no easy way for a user to find out what applications reside in the card. The problem is compounded if the user holds two or more multi-application cards. One solution is to permanently print the symbols or logos of the applications on the card at the time of issuance. As can be appreciated, however, this solution is inadequate. Even though different applications may be loaded and removed from the card from time to time, the permanent printing of the logos cannot be changed to accurately reflect the currently loaded

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applications. Another solution is to use an external reader device that slips over the card to view the card's content. Such a device, however, is too bulky to carry around with the card”.

**As to dependent claim 15, “wherein: the storage unit is configured to store a given part of the first identifier, visible information, the content data, the replay program, and a title of the content data that are related to one another; the writing apparatus further comprises: a display controller configured to read the visible information and title from the storage unit and output a display signal to display the visible information and title”**

however ‘944 teaches that the interface apparatus is able to display the icons and titles of application available in col. 2, lines 18-25;

**“and a display configured to receive the display signal from the display controller and display the visible information and title; and the writer writes the content data and replay program corresponding to the given part of the first identifier to the data area of the storage device”** however ‘944 teaches that a loader program verifies and authenticates the external system has the appropriate authority in col. 2, line 54 through col. 3, line 9. The motivation to combine ‘706 and ‘944 is the same as stated above in claim 14.


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*Conclusion*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen C Tran whose telephone number is (571) 272-3842. The examiner can normally be reached from 6:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Ellen Tran  
Patent Examiner  
Technology Center 2134  
19 June 2007